

REMARKS

This Application has been carefully reviewed in light of the Office Action. Applicants respectfully request reconsideration and favorable action in this case.

Response to Applicants' Arguments

M.P.E.P. § 707.07(f) states that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." The Office Action did not respond to the substance of Applicants' arguments made after page nine of the Response mailed February 15, 2005. If the present rejections are maintained, Applicants respectfully request that the Examiner respond to the substance of each of Applicants arguments.

Allowable Subject Matter

Applicants note with appreciation the indication by the Examiner that Claims 7, 8, 20, 21, 33 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For the reasons discussed below, Applicants respectfully contend that each of Claims 7, 8, 20, 21, 33 and 34 are currently in condition for allowance.

Section 103 Rejections

The Office Action rejects Claims 1, 2, 6, 11-15, 19, 24-28, 32 and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,600,710 issued to Weisser et al., ("*Weisser*") and in view of U.S. Patent No. 6,301,349 issued to Malik ("*Malik*"). Applicants respectfully traverse these rejections for the reasons stated below.

Claims 1, 14, and 27 are directed to systems or methods including determining whether a messaging system is available and, if the messaging system is not available, queuing a request and maintaining a telecommunications connection between an access controller and a user while the request is queued. Applicants respectfully submit that Claims 1, 14, and 27 are allowable over the combination of *Weisser* and *Malik*: (1) because the proposed combination fails to disclose all the elements of the claims, (2) because the prior art fails to provide the required teaching, suggestion, or motivation to combine *Weisser* and

Malik in the manner the Examiner proposes, and (3) because *Weisser* and *Malik* explicitly teach away from a combination.

First, Applicants respectfully submit that neither *Weisser* nor *Malik*, either alone or in combination, disclose, teach, or suggest each element of Claims 1, 14, and 27. The Office Action admits that *Weisser* does not disclose a messaging system. See Office Action, page 3, item 3, line 8. Instead, *Weisser* discloses receiving a request to be connected with a called party. *Weisser* does not contemplate that the called party can be a messaging system. *Id.* The Office Action attempts to combine the voicemail service (“VMS”) of *Malik* with the teachings of *Weisser*. See Office Action, page 3, item 3, lines 8-9. However, the VMS of *Malik* is used to connect with unanswered calls that are directed to the called party, if the called party is unavailable. There is no disclosure, either in *Weisser* or *Malik*, for even the possibility that a messaging system may be unavailable. For at least these reasons, Applicants respectfully submit that Claims 1, 14, and 27 are patentably distinguishable from *Weisser* and *Malik* and request that the rejections of Claims 1, 14, and 27 be withdrawn.

Second, Applicants respectfully submit that the Examiner’s proposed motivation to combine *Weisser* and *Malik* is insufficient to support a *prima facie* case of obviousness. The Office Action contends that:

It would have been obvious to one skilled at the time of the invention was made to modify *Weisser et al* to have "a messaging system" as taught by *Malik* such that the modified system of *Weisser et al* would be able to support the system user conveniences of controlling a messaging system in an environment as taught by *Weisser et al*.

Office Action, page 3. The Examiner has not indicated any portions of either *Weisser* or *Malik* as providing support for the proposed motivation, and the Examiner has not asserted that the proposed motivation would fall within the knowledge generally available to one of ordinary skill in the art. Thus, to the extent that this rejection is maintained by the Examiner and based on “Official Notice,” “well-known art,” common knowledge, or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.

M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an Applicant's disclosure. As the M.P.E.P. states:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art [at the time of the invention.]

M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. Moreover, "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

With respect to the Examiner's proposed combination, the Examiner has not provided any support for the proposed motivation to combine the teachings of *Weisser* with *Malik*. First, the Examiner has not cited any portion of *Weisser* or *Malik* that would motivate one skilled in the art to combine the references. Second, nothing in *Weisser*, *Malik*, or the knowledge generally available to those of ordinary skill in the art at the time of the invention teaches, suggests, or motivates in any way the proposed combination of *Weisser* and *Malik*. The Examiner's proposed motivation, in hindsight with the benefit of Applicants' claims as a roadmap, is insufficient.

In addition, it would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to even attempt* to incorporate into the teachings of *Weisser* a messaging system, as proposed by the Examiner, because *Weisser* and

Malik teach different and mutually exclusive methods for handling calls when the called party is unavailable. *Weisser* teaches that calls are directed to a Service Node to play advertisements to the caller until the called party is available. *Weisser*, Abstract. *Malik*, on the other hand, teaches that calls are directed to a voicemail service when the called party is not available. *Malik*, Abstract. Moreover, a purpose of the invention in *Weisser* is to maintain a connection with a calling party until a called party becomes available, while as discussed above, *Malik* directs calls to a voicemail service when a called party is unavailable. *Weisser*, column 8, lines 11-14. Thus, *Weisser* and *Malik* lack the required motivation to establish a *prima facie* case of obviousness.

Third, the teachings of *Malik* explicitly teach away from a combination with *Weisser*. *Malik* explains that “the present invention minimizes the delay suffered by the caller during the process of connection.” *Malik*, column 2, lines 43-45 (emphasis added). This is contradictory to the system of *Weisser* that “uses an AIN to allow a called party to place a call on hold while the called line is busy,” and thereby introduce a delay for the calling party. *Weisser*, column 8, lines 54-56. This illustrates, once again, that the combination of *Weisser* and *Malik* is improper and cannot be used in an obviousness rejection under 35 U.S.C. § 103.

Accordingly, because the proposed combination fails to disclose all the elements of the claims, because the prior art fails to provide the required teaching, suggestion, or motivation to combine *Weisser* and *Malik* in the manner the Examiner proposes, and because *Weisser* and *Malik* explicitly teach away from a combination, Applicants respectfully submit that the Examiner’s conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicants respectfully submit that the Examiner’s proposed combination of *Weisser* and *Malik* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicants’ claims in a manner not supported by the teachings of either *Weisser* or *Malik*. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 1, 14, and 27.

Claims 2, 6, and 11-13 depend from independent Claim 1. Claims 15, 19, and 24-26 depend from independent Claim 14. Claims 28, 32, and 37-39 depend from

independent Claim 27. Therefore, Applicants respectfully submit that claims 2, 6, 11-13, 15, 19, 24-26, 28, 32, and 37-39 are patentably distinct from the cited references, for example, for at least the reasons discussed above regarding Claims 1, 14, and 27.

The Office Action rejects Claims 3-5, 16-18 and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over *Weisser et al* as applied to Claim 1 above, and in view of U.S. Patent No. 6,519,333 issued to Malik ("*Malik-333*"). Applicants respectfully traverse these rejections for the reasons stated below.

Claims 3-5 depend from independent Claim 1. Claims 16-18 depend from independent Claim 14. Claims 29-31 depend from independent Claim 27. Therefore, Applicants respectfully submit that claims 3-5, 16-18, and 29-31 are patentably distinct from the cited references, for example, for at least the reasons discussed above regarding Claims 1, 14, and 27.

Additionally, the Examiner has not cited a proper motivation to combine *Weisser* and *Malik-333*, and the combination of *Weisser* and *Malik-333* is improper. The Office Action states that "[i]t would have been obvious to one skilled at the time the invention was made to modify *Weisser et al* to have the 'determining a class of service. . . queuing. . . CoS' as taught by *Malik-333* such that the modified system of *Weisser et al* would be able to support the system users conveniences of determining the CoS for queuing." Office Action, page 4. Thus, the Office Action essentially states that the motivation to modify *Weisser* is so that the modified system includes the missing claim element. This is an improper motivation for modifying a reference to support a rejection under 35 U.S.C. § 103.

Further, the Office Action rejects Claims 9, 10, 22, 23, 35, and 36 under 35 U.S.C. § 103(a) as being unpatentable over "*Weisser*" and in view of *Malik* and in further view of U.S. Patent No. 6,412,048 issued to Chauvel et al. ("*Chauvel*"). Applicants respectfully traverse these rejections for the reasons stated below.

Claims 9 and 10 depend from independent Claim 1. Claims 22 and 23 depend from independent Claim 14. Claims 35 and 36 depend from independent Claim 27. Therefore, Applicants respectfully submit that claims 9, 10, 22, 23, 35, and 36 are patentably

distinct from the cited references, for example, for at least the reasons discussed above regarding Claims 1, 14, and 27.

The Office Action rejects Claim 40 under 35 U.S.C. § 103(a) as being unpatentable over *Weisser*, and in view of *Malik*, and U.S. Patent No. 6,529,500 issued to Pandharipande ("*Pandharipande*"). The Office Action rejects Claim 41 under 35 U.S.C. § 103(a) as being unpatentable over *Weisser et al.*, as stated in Claim 40 above, and in view of *Malik*, *Malik-333* and *Pandharipande*. The Office Action rejects Claim 42 under 35 U.S.C. § 103(a) as being unpatentable over *Weisser et al.*, as stated in Claim 40 above, and in view of *Malik*, *Pandharipande*, and in view of U.S. Patent No. 6,324,271 issued to Sawyer et al. ("*Sawyer*"). Applicants respectfully traverse these rejections for the reasons stated below.

Regarding Claim 40, the Office Action relies on *Weisser* in view of *Malik* as applied to Claim 1. As discussed above regarding Claim 1, the Office Action has stated no motivation to combine the VMS of *Malik* with the teachings of *Weisser*, the proposed combination is improper, and the proposed combination fails to disclose, teach, or suggest a messaging system being unavailable. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 40.

Claims 41 and 42 depend from independent Claim 40. Therefore, Applicants respectfully submit that claims 41 and 42 are patentably distinct from the cited references, for example, for at least the reasons discussed above regarding Claim 40.



Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Chad C. Walters".

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